REMARKS

Status of the Claims

Claims 30-81 were previously pending. Claim 31 has been canceled without prejudice or disclaimer. Accordingly claims 30, and 32-81 are pending and at issue.

Claim 30 has been amended to include salts of the recited compound. Support for this amendment can be found in claim 31 as filed. Claims 40, 43, and 66 have been amended to depend from claims 38, 41 and 65 respectively. Claims 68-81 have been amended to recite a method of administering an active agent. Claims 68 and 74-81 have been amended to delete "in need of said agent".

Status of the U.S.S.N. 10/142,009

The specification has been amended to state that U.S.S.N. 10/142,009 is now U.S. Patent No. 6,669,467.

Rejections Under 35 U.S.C. § 112, second paragraph

Claims 40, 43, 66, and 68-73, 76, and 78 stand rejected as indefinite.

The Examiner states that claim 40 and 66 lack antecedent basis, and claim 43 appears to claim a combination of insulin and low molecular weight heparin. The Examiner suggests that claim 40 should depend from claim 38, claim 43 should depend from claim 41, and claim 66 should depend from claim 65. These claims have been amended as suggested by the Examiner. Applicants appreciate the Examiner's attention to this matter.

The Examiner states that the preamble to claim 68 indicates that a biologically active agent is to be administered, but the composition to be administered, as defined in claim 32, is not limited to biologically-active agents. Claim 32 is drawn to active agents in general. While applicants respectfully disagree that this makes claim 68 indefinite, claims 68-81 have been

amended to recite a method of administering an active agent. Applicants request that this rejection be withdrawn.

Claim 30 is objected to because it does not conclude with a period. Claim 30 has been amended to conclude with a period.

Claims 41, 57, and 67 stand rejected because the Examiner states that "growth releasing hormones" and "growth hormone-releasing hormones" are synonyms. "Growth releasing hormones" have been deleted from these claims.

Obviousness-Type Double Patenting

Claims 30-36, 39, 41, 42, 47, 51, 52, 54, 57, 59, 63, 64, 67, 68, 70 and 71 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-6 of U.S. Patent No. 6,693,073. Claims 30-47, 51-68, 70, and 71 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-13 of U.S. Patent No. 6,440,929. Claims 30-38, 47-55, 63-66, and 68-75 rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-19 of U.S. Patent No. 6,391,303. While applicants respectfully disagree with these rejections, submitted herewith is a terminal disclaimer over U.S. Patent Nos. 6,693,073, 6,440,929, and 6,391,303. Applicants request that this rejection be withdrawn.

Rejections Under 35 U.S.C. § 103(a)

Claims 30-81 stand rejected under 35 U.S.C. § 103(a) as being obvious over Leone-Bay et al. (U.S. Pat. No. 5,643,957). The present application is entitled to a priority date of *at least* April 1, 1996. The '957 Patent was filed on October 25, 1994 and issued on July 1, 1997. Assuming, without admitting, that the '957 Patent is prior art, it is prior art only under § 102(e). Therefore, the '957 Patent is not a proper reference for an obviousness rejection since the '957 Patent and the present application are subject to an obligation of assignment to Emisphere Technologies, Inc.
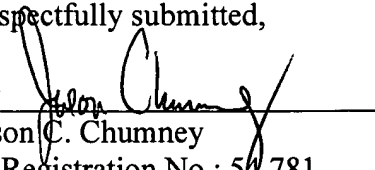
Submitted herewith is a declaration under §103(c). Applicants request that this rejection be withdrawn.

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Dated: October 25, 2004

Respectfully submitted,

By_____
Jason C. Chumney
    Registration No.: 50,781
DARBY & DARBY P.C.
P.O. Box 5257
Previously Presented York, Previously Presented York 10150-5257
(212) 527-7700
(212) 753-6237 (Fax)
Attorneys/Agents For Applicant